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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY, DOCKET NO.	CONFIRMATION NO.
09/724,978	11/28/2000	D. David Nason	750037.401C4	8343

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EXAMINER

BAYERL, RAYMOND J

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 03/04/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/724,978

Applicant(s)

NASON ET AL.

Examiner

Raymond J. Bayerl

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply.

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2 - 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 - 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10, 11, 12, 13</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2173

1. The previous Office Action (paper #9, mailed 2 February 2004) did not take into consideration applicant's 1 August 2003 preliminary amendment, nor the information disclosure statements filed 28 May 2003, 1 July 2003, 1 August 2003, 4 September 2003, since the papers had not been matched with the file. Therefore, the previous non-final office action is hereby VACATED, and replaced by the one that now follows.

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119, 120 as follows:

An application in which the benefits of an earlier application are desired must contain a **specific** reference to the prior application(s) in the first sentence of the specification.

In the instant case, applicant has not updated the status of parent application 09/666,032 in view of its having matured into a US Patent. Also, applicant supplies the filing date of 13 November 2000 for one of the US Provisional priority documents, but without the corresponding US serial number.

3. The disclosure is objected to because of the following informalities: the appendices A – H cannot be supplied as pages to be printed in a US Patent under 37 CFR 1.96(b) because the size exceeds 300 lines (see MPEP 608.05(a)). Also, the provision for a computer-related appendix set forth in 37 CFR 1.96 only pertains to computer program listings, and not the descriptive material as appears in the appendices.

Appropriate correction is required.

Art Unit: 2173

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "The method of claim 4" makes claim 4 uncertain. To expedite prosecution, the Examiner presumes that applicant had intended claim 2 as the parent, as in similar claim 17.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2173

6a. Claims 2 – 32 are provisionally rejected under the judicially created doctrine of double patenting over the claims of copending Application Nos. 09/263,612, 09/724,919, 09/726,262, 09/960,850, 10/114,857. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

6b. Claims 2 – 32 are rejected under the judicially created doctrine of double patenting over the claims of U. S. Patent Nos. 6,678,007 B2, 6,661,435 B2, 6,677,964 B1, 6,630,943 B1, 6,590,592 B1, 6,593,945 B1, 6,437,809 B1, 6,330,010 B1, 6,337,717 B1, 6,639,613 B1, 6,310,603 B1, 6,426,762 B1, 6,433,799 B1, 6,018,332, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patents.

The subject matter claimed in the instant application is essentially covered by the patents and applications, since the patents and the applications are claiming common subject matter, as follows: the commonly-assigned claims presented in these various applications and patents are all essentially directed to the concept of using a secondary user interface in parallel with the user interface provided by the native operating system, as substantially recited in the present claims, in which calls are modified relative to the original user's I/O in the operating system's GUI to accomplish such structure.

7. The following is an examiner's statement of reasons for allowance:

The Examiner has carefully considered applicant's independent claims 2, 15, 25, 32. The claimed "enabling" of "the display of data" by a "size" "swapping" operation that is "transparent to the operating system display interface" for a "first display area", in which "an application" is given control of input and output to and from a "first display

Art Unit: 2173

area" and a "second display area" created by "resizing the first display area", was not taught nor suggested by the prior art now made of record (see attached forms PTO 1449, 892).

Typical in the prior art approach to handling dedicated screen regions that operate in apparent independence of the main client area of the operating system are such disclosures as Oran et al. (US #5,617,526) and Malamud et al. (US #5,825,357), with a task-bar interface, and Ludolph (US #5,874,958) and Hullot et al. (US #5,146,556), who use similar display objects. But while these systems give control of a separate "second display area" to a process that might read upon applicant's "application", the overall interface remains under the auspices of the "operating system", and not in a manner that is "transparent to the computer operating system display interface".

As further examples of display screens that suggest "resizing the first display area" so as to allow for a "second display area" as a "remainder", Karaki et al. (US #5,612,715) and Bishop et al. (US #4,972,264) each work with display adapter resolution to create a joint, multi-region display that is separately sourced. However, in these disclosures, there is no real suggestion that the control over an initial "first" and a supplemental "second area" is "transparent to the computer operating system display interface"—the display in each case is still under central control.

This is not to say that operating system-driven interfaces at the time of applicant's invention did not support the "intercepting" of "calls" *per se*, in displays that are supplemental to the one driven by the "operating system". Brown et al. (US

Art Unit: 2173

#5,673,403), Celi, Jr. et al. (US #5,745,762) and Blackmon et al. (US #6,118,428) show a windowing arrangement based upon diverse operating systems' output. However, such teachings are nevertheless of having a single supervisory operating system responsible for the entire display, and thus, the externally-driven regions cannot be said to be "transparent to the operating system display interface".


Finally worthy of mention, as regards the support within an overall computer system of "application"-driven "display area" regions whose content is derived independently of the "operating system" that, by default, controls an entire "first area", are Gurley (US #5,036,315) and Hanson (US #6,148,346). Gurley provides a second computer a client area within a first, as does Hanson, who even goes so far as to provide an operating system independent device driver portion. However, Gurley's GUI shares the limitation noted above, of leaving the total region within "operating system" administration. Hanson, while porting a display region to an "application" that forwards GUI components to the display, is also lacking in a teaching or suggestion that the resulting "display area" is obtained by modifying the layout so as to include a "second display area" that is produced by selective resizing that is "transparent to the operating system display interface"—the independent driver arrangement of Hanson is instead concerned with connectivity to various peripheral devices such as printers, with foreign OS formats.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (703) 305-9789. The examiner can normally be reached on M - F from 10:00 AM to 5:00 PM.

Art Unit: 2173

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
RAYMOND J. BAYERL  
PRIMARY EXAMINER  
ART UNIT 2173

1 March 2004